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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/253,810	02/19/1999	JEFFREY W. BRUNER	21,530-B-USA	6116

7590 10/23/2003

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EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/253,810

Applicant(s)

BRUNER, JEFFREY W.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed July 17, 2003, has been entered. Claims 12, 17, 20, and 23 have been amended as requested. The pending claims are 12-24.
2. Said amendment is sufficient to withdraw the 112, 1<sup>st</sup> rejection set forth in section 4 of the last Office Action. Additionally, said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejection set forth in section 8.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 17 stands indefinite because it is unclear whether the arrangement of “yarns” recitation in claim 17, line 9 refers to the warp yarns, the fill yarns, the pile yarns, or all of said yarns.
6. Claim 20 is indefinite for the use of the phrase “improved adherence of surface fibers.” It is unclear what this improvement is in comparison to.

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 12-15 and 17-24 stand rejected under 35 USC 102(b) as being anticipated by JP 06-002240 issued to Imose for the reasons of record.

***Claim Rejections - 35 USC § 103***

9. Claim 16 stands rejected under 35 USC 103(a) as being unpatentable over JP 06-002240 issued to Imose in view of *Woven Pile Fabrics in the Automotive Industry*, Moulin et al. for the reasons of record.

***Response to Arguments***

10. Applicant's arguments filed with the Amendment of July 17, 2003, have been fully considered but they are not persuasive. In particular, applicant traverses the above Imose rejection by arguing that the sheath of the reference is not a thermoplastic sheath (Amendment, page 7, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs). Specifically, applicant argues that Imose teaches away from the present invention by requiring "no less than 40% by weight of non-thermoplastic material." The examiner respectfully disagrees.
11. First, applicant's claims do not exclude the presence of some non-thermoplastic material in the sheath, since claims recite open language of "comprise" or "consisting essentially of." Secondly, the examiner disagrees with applicant's interpretation of the Imose reference. Imose teaches the sheath comprises a thermo-fusion bonding property fiber and a non-thermo-fusion bonding property fiber (section [0010]). The difference between the thermo-fusion fiber and the

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non-thermo-fusion fiber is the melting point. The thermo-bonding fusion fiber is a thermoplastic fiber that has a melting point that is at least 50 C lower than the non-thermo-bonding fusion thermoplastic fiber (section [0010] and [0011]). For example, the thermo-fusion fiber may be a low melting point polyester or polyamide fiber, while the non-thermo-fusion fibers may be higher melting polyester fiber or a polyolefin fiber (sections [0011] and [0012]). In one embodiment, the sheath comprises a low melting point thermoplastic polyamide fiber and higher melting point thermoplastic polyester fiber (section [0020]).

12. Thus, Imose's terms "thermo-bonding" and "non-thermo-bonding" are not synonymous with the claim term "thermoplastic." Both Imose's fibers are thermoplastic fibers (i.e., fibers which are capable of being melted or fused), but at the fusion temperature only one fiber is melted or fused, while the other remains unmelted or non-fused due to its melting temperature being above the fusion temperature. As such, Imose clearly teaches the presently claimed "thermoplastic sheath." Therefore, applicant's arguments are found unpersuasive and the above Imose rejection is maintained.

13. With respect to the claims containing "consisting essentially of," contrary to applicant's discussion at page 6 of the Amendment, said claims 20-24 were not rejected under 112 for the use of the transitional phrase "consisting essentially of." It merely noted in the 102 prior art rejection of claims 20-24 that the phrase "consisting essentially of" is construed as equivalent to "comprising" since there was nothing on record establishing that the presence of some non-thermoplastic material in the sheath would materially affect the basic and novel characteristics of the invention. The burden was shifted to applicant to show that the introduction of said non-thermoplastic material would materially change the characteristics of the present invention.

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14. In response to this shift of burden, applicant has amended said claims to include the preamble limitation of “a method of making a composite fabric capable of providing a wide variety of surface textures and fiber densities and providing improved adherence of surface fibers.” Applicant asserts these features reflect the basic and novel characteristics of the invention (Amendment, page 6, 2<sup>nd</sup> paragraph). Applicant also asserts that these features cannot be achieved by the Imose invention (Amendment, page 7, 3<sup>rd</sup> paragraph). The examiner respectfully disagrees with applicants assertions. As noted above, Imose clearly teaches a thermoplastic sheath. Additionally, the new limitation is a preamble limitation which is not necessarily accorded patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, the phrase “capable of...” is not necessarily accorded patentable weight, since it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

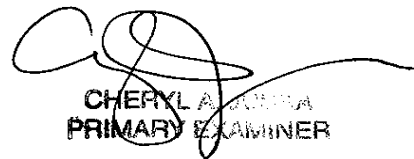
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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
October 20, 2003